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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,048	10/02/2003	John D. Inelli	ROYAL-4	7770

23599 7590 06/27/2005

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EXAMINER

GREEN, CHRISTY MARIE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,048

Applicant(s)

INELLI, JOHN D.

Examiner

Christy M. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a second office action for serial number 10/676048, entitled Window Sleeve for Mounting Framed Windows, filed on October 2, 2003.

Response to Amendment

In response to the examiner's office action mailed 12/6/04, the applicant has appeared to cancelled claims 9 and 20 (although within the listing of the claims, claim 20 is stated to be claim 12; however since claim 12 is in its original state and it appears that this is just a typographical error, the examiner interprets claim 20 to be canceled), amended claims 1-3 and 10.

Claim Objections

Claim1 is objected to because of the following informalities: regarding the limitations the top and bottom walls, are theses supposed to be the upper and lower walls? Also, in line 6 following the limitation, top and bottom walls joint by side walls, the walls each having an inner surface...; "the walls" is unclear, is applicant referring to all walls, top, bottom and side, or just top/ bottom or the side walls; until further clarification, the examiner will interpret the limitations accordingly. Appropriate correction is required.

Claims 21-23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that these claims are depending from a canceled claim "20". Accordingly, the claims 21-23

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and 25 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the extension" in line 10. There is insufficient antecedent basis for this limitation in the claim. Since this limitation was not previously recited within the claim and is not disclosed within the specification nor the drawings, it is unclear and therefore lacks antecedent basis. Until further clarification, the examiner interprets this to be a typo and will interpret it as "the extrusion".

Claim 1 is considered indefinite because it is unclear whether applicant intends to claim a combination or subcombination. In claim 1, applicant initially claims a window sleeve arrangement, without claiming the window unit, an opening through a building wall, the exterior and interior surface of the wall, or the glass pane, the window unit, an opening through a building wall, the exterior and interior surface of the wall, or the glass pane in functional language. However, applicant then claims (lines 11, 13, 20 and 22) the window sleeve arrangement in combination with the window and the exterior surface of the building wall, respectively. The examiner is considering the claim to be a subcombination. However, applicant should clarify/amend which is to be considered in the claim, and ensure that all claims that depend from it are consistent.

Claim 24 is unclear with regards to "the walls", it is unclear which walls applicant is referring to, the walls of the sleeve arrangement, or the inner walls of the stop arrangement. Until further clarification is made the examiner will interpret the claim accordingly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

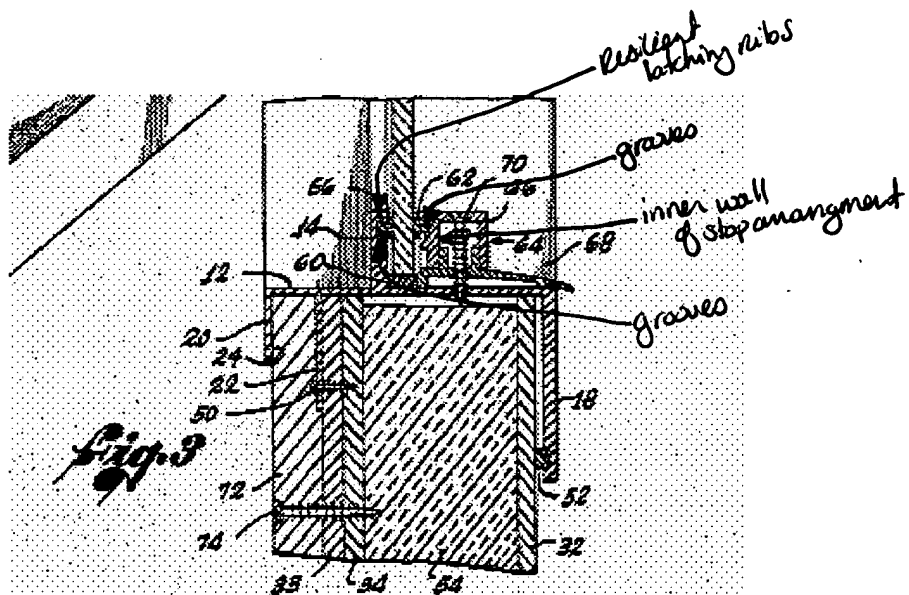
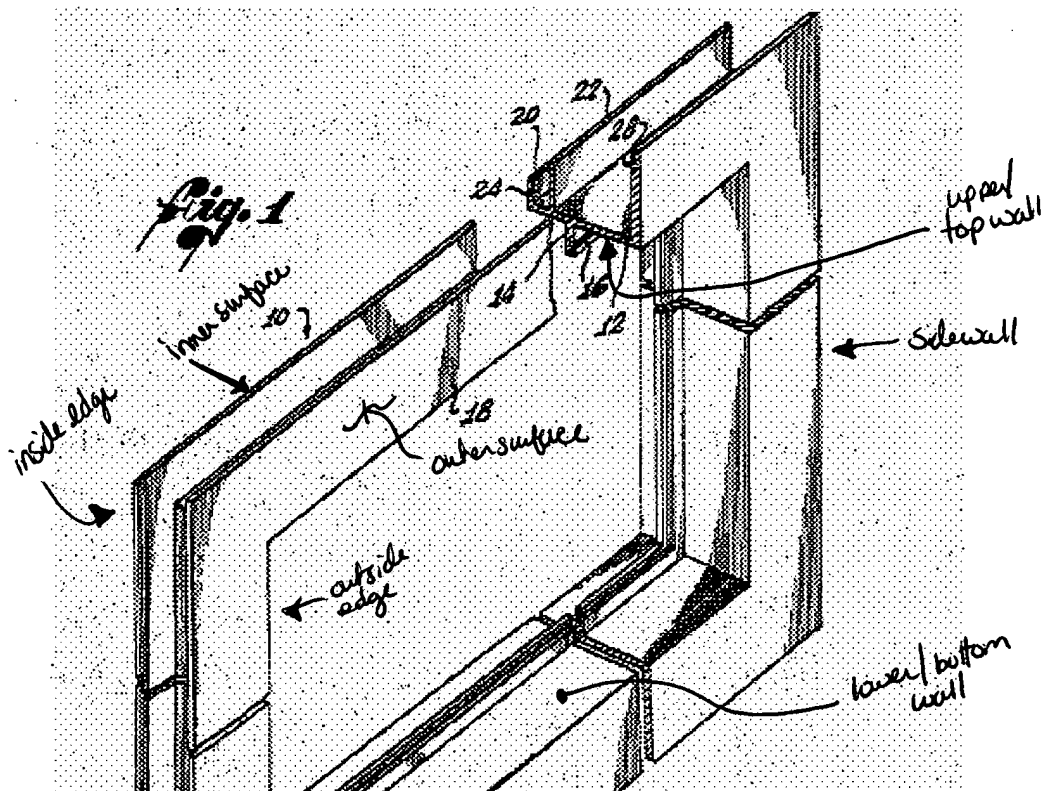
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7, 8, 10, 17-19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riegelman, Jr., US Patent # 3,768,220 in view of Biro, US patent # 4,624,091.

Riegelman discloses the claimed invention a top and bottom walls (see figure 1 below), joined by side walls (see figure 1 on next page), the walls having an inner surface and an outer surface (see figure 1 on the next page), an inner edge and outer edge (see figure 1 on the next page), a first exterior flange (22) disposed around the walls of the window sleeve and extending laterally outward from the outer surfaces of the walls at a location intermediate the inner and outer edges of the walls, a second outer flange (24) located substantially at the outer edges of the walls and spaced from the first outer flange (22) defining a gap therebetween (figure 1), an inner flange (14) disposed adjacent to the outer edges of the walls and extending inwardly from the inner surface of the walls, the inner flange forming a stop (figure 3 on next page) for engaging

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the window unit, an inside stop arrangement (64) positioned in a spaced relation to the inner flange (14).



Riegelman also discloses the inside stop arrangement (64) includes a molding strip (62); the molding strip having a connection (interpreted to be the flanges of the molding strip or sealing strip, where the strip can be held in the inner wall of the stop arrangement); where the molding strip is fastened in place by a *separate* fastener (70 – via the stop arrangement), the fastener being a nail (column 3, line 25); the walls extending from the inner flange (14) and to the first outer flange (22) are planar and unobstructed (figure 3); the sleeve arrangement further includes interior molding (56) attached by a snap-in coupling with grooves in the outer edges of the wall and resilient latching ribs on the molding which are received in the grooves (see figure 3 on previous page).

Riegelman does not disclose the top, bottom and side walls are a continuous extrusion of plastic material having abutting edges positioned at cuts through the extrusion, and the plastic is PVC, polyurethane, polypropylene, or ABS; the interior molding is pivoted on the walls at the inner edges thereof; and, the moldings are coextruded with the walls of the window sleeve arrangement.

Biro teaches that it is known in the art to provide the top, bottom and side walls are a continuous extrusion of plastic vinyl material (column 4, lines 56-59) having abutting edges positioned at cuts (180) through the extrusion (column 5, lines 26-30). It would have been obvious to one having ordinary skill in the art at the time the rejection was made to provide the continuous extrusion of plastic material as taught by Biro with the frame of Riegelman in order to provide a rigid sleeve arrangement, and to create a

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mitered appearance. Also, it is common knowledge to those of ordinary skill to choose materials that has sufficient strength for the intended use of that material.

Regarding the limitations the interior molding is pivoted on the walls at the inner edges thereof; and, the moldings are co extruded with the walls of the window sleeve arrangement.

It would have been obvious to one having ordinary skill in the art to provide the molding to be pivoted on the walls at the inner edges thereof to accommodate a window being placed in the sleeve arrangement at a slight angle. Since the molding is a resilient material, the molding could be pivoted on the walls to allow for a snug fit of a slightly angled glazing.

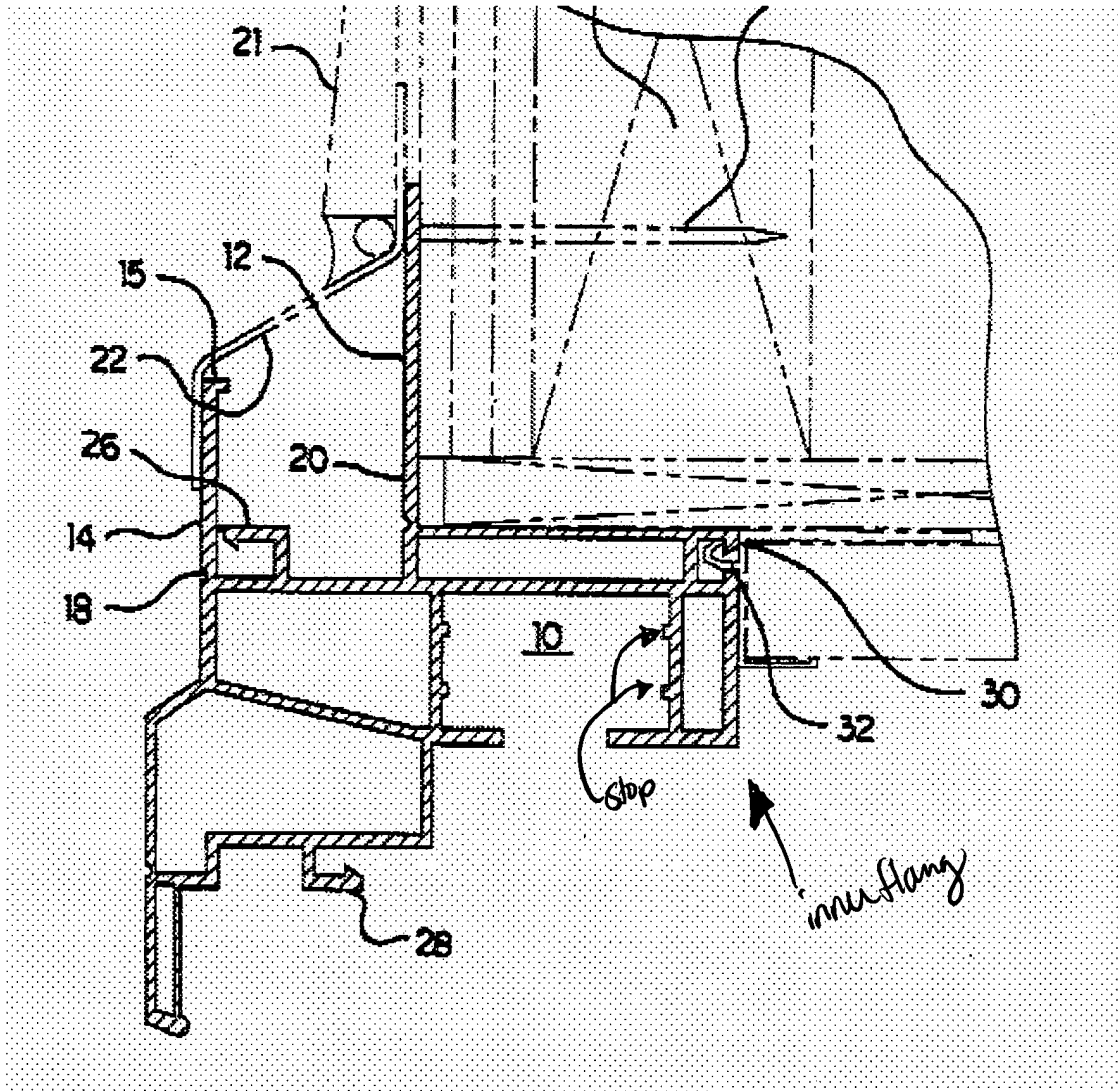
Also, It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the moldings to be co extruded or integral with the walls of the window arrangement, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Claims 1, 5, 6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Card, US Patent # 5,557,894 in view of Biro.

Card discloses the claimed invention including a window sleeve arrangement (figure 2) comprising a top and bottom walls, joined by side walls, the walls having an inner surface and an outer surface (inherent if it is a window frame sleeve an inner edge and outer edge (column 2, lines 20-26), a first exterior flange (15) disposed around the walls of the window sleeve and extending laterally outward from the outer surfaces of

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the walls at a location intermediate the inner and outer edges of the walls (figure 2), a second outer flange (14) located substantially at the outer edges of the walls and spaced from the first outer flange (15) defining a gap (where the number 20 is located in figure 2) therebetween, an inner flange (see figure 2 below) disposed adjacent to the outer edges of the walls and extending inwardly from the inner surface of the walls, the inner flange forming a stop (see figure 2 below) for engaging the window unit, an inside stop arrangement (at 28) positioned in a spaced relation to the inner flange;



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the first outer flange (12) has a nail (17) passing through nail fin (12 – column 3, lines 50-60); the fasteners (17) are nails (figure 3); the inner and outer surfaces of the walls are planar and unobstructed.

Card does not disclose that the window sleeve is molded of plastic. Biro teaches that it is known in the art to provide the top, bottom and side walls are a continuous extrusion of plastic vinyl material (column 4, lines 56-59) having abutting edges positioned at cuts (180) through the extrusion (column 5, lines 26-30). It would have been obvious to one having ordinary skill in the art at the time the rejection was made to provide the continuous extrusion of plastic material as taught by Biro with the frame of Card in order to provide a rigid sleeve arrangement that will not rust, and to create a mitered appearance. Also, it is common knowledge to those of ordinary skill to choose materials that has sufficient strength for the intended use of that material.

Response to Arguments

Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive.

Regarding all of the remarks directed towards the newly amended limitations added to the claims, the examiner has recognized them and have addressed them accordingly within the office action above, specifically pertaining to the material of use, extruded plastic material and are moot in view of new grounds of rejection.

In response to applicant's argument that Card '894 and Lagrue et al. '854 is directed is nonanalogous art or are directed to different fields of endeavor in that the frame of Card is for use in buildings, and the , and the supporting frame in Lagrue is for

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automotive vehicles, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Although the Lagrue reference is for a frame for an automotive window, and Card is used for buildings, the applicant is only positively claiming the window sleeve arrangement and not the building wall as stated in the 112 combination/subcombination rejection above. The examiner is interpreting the claims to the subcombination of the sleeve arrangement until further clarification is made.

Conclusion

Any inquiry concerning this communication or earlier communications^{*} from the examiner should be directed to Christy M. Green whose telephone number is 571-272-6844. The examiner can normally be reached on M,T,TH 10:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cg

June 16, 2005


Carl D. Friedman
Supervisory Patent Examiner
Group 3600